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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
		RM2270331	

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EXAMINER

1642

ART UNIT

PAPER NUM

05/31/98

DATE MAILED:

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

### OFFICE ACTION SUMMARY

Responsive to communication(s) filed on June 5, 1998

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

Ordered statutory period for response to this action is set to expire 3 month(s), or thirty days, never is longer, from the mailing date of this communication. Failure to respond within the period for response will cause application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 6(a).

#### Disposition of Claims

Claim(s) 1-15 is/are pending in the application.  
Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
Claim(s) \_\_\_\_\_ is/are allowed.  
Claim(s) \_\_\_\_\_ is/are rejected.  
Claim(s) \_\_\_\_\_ is/are objected to.  
Claim(s) 1-15 are subject to restriction or election requirements.

#### Specification Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

Certified copies not received: \_\_\_\_\_.

Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Restriction/Election Fax Transmission  
Notice of Reference Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_.

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

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Please Note: In an effort to enhance communication with our customers and reduce processing time, Group 1642 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-305-3704. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Paula K. Hutzell, Ph.D., Supervisory Patent Examiner, at Paula.Hutzell@uspto.gov or (703)308-4310. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

***Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-6, 11-12, and 14-15 drawn to a polynucleotide sequence and recombinant cell, classified in class 536, subclass 23.1+.
  - II. Claims 7-9 and 13, drawn to a protein sequences, classified in class 530, subclass 350+.
  - III. Claim 10 drawn to an antibody, classified in class 350, subclass 387.1+.

2. The inventions are distinct, each from the other because of the following reasons:

The nucleic acid of Group I and the antibody of Group III are different chemical compositions with different chemical properties and different methods of use. The examination of both groups would require different searches in the U.S. Patent Shoes and the scientific literature and would require the consideration of different patentability issues.

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3. The proteins of Group II are related to the antibodies of Group III by virtue of being the cognate antigen, necessary for the production of antibodies. Although the protein and antibody are related due to the necessary steric complementarity of the two compositions, they are distinct inventions because they are physically and functionally distinct chemical entities, and because the protein can be used for other materially different processes in its own right, such as in a method of treatment, or in assays for the identification of agonists or antagonists for the protein. The examination of both groups would require different searches in the U.S. Patent Shoes and the scientific literature and would require the consideration of different patentability issues.

The proteins compositions of Group II is related to the nucleic acids of Group I since the polynucleotides encode the protein compositions. Although they are related since the DNA encodes the specifically claimed protein, they are distinct inventions because they are physically and functionally distinct chemical entities, and the protein product can be made by another and materially different process, such as by synthetic peptide synthesis or purification from non-recombinant cells. Further, the DNA may be used for processes other than the production of the protein, such as a nucleic acid hybridization assay. The examination of both groups would require different searches in the U.S. Patent Shoes and the scientific literature, and would require the consideration of different patentability issues.

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4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. A telephone call was made to Cheryl L. Becker on March 10, 1999 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

7. Any inquiry concerning the communication or earlier communications from the examiner should be directed to Timothy A. Worrall, Ph.D. whose telephone number is (703) 308-9348. The examiner can normally be reached on Monday through Friday from 8:30 A.M. to 5:00 P.M.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell, can be reached on (703) 308-4310. The fax phone number for this Group is (703) 305-3014.

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Communications via Internet-e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [paula.hutzell@uspto.gov].


All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements under 35 sequence U.S.C.122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997, at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.



Timothy A. Worrall, Ph.D.

March 16, 1999



**PAULA K. HUTZELL**  
**SUPERVISORY PATENT EXAMINER**